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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,685	01/04/2001	John B. Ferber	08011.3000-00000	1659
22852	7590	07/22/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,685

Applicant(s)

FERBER, JOHN B.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5, 8, 10-11, 16-17, 21-22, 25, 28-29, 32 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (US 5,933,811).

Angles et al. teach a method and system for delivering customized advertisements within interactive communication environment, comprising:

As per claims 1, 11, 17, 22 and 29,

registering a wireless device to receive advertising messages (column 3, lines 19-29);

receiving registration information including at least a wireless device number and storing said information in a database (column 3, lines 19-29);

receiving advertising messages from advertisers (column 3, lines 41-46);

sending the advertising messages to a registered wireless device (column 3, lines 41-46);

remunerating users for accepting the advertising messages to their registered wireless devices (column 16, lines 31-37).

As per claims 2, 10, 16, 21, 28, 35,

receiving payment from the advertisers for sending the advertising messages (column 21, lines 19-24; column 16, lines 31-37).

As per claims 5, 25 and 32, said method and system, wherein users are remunerated monetary compensation for accepting the advertising messages (column 21, lines 19-24; column 16, lines 31-37).

As per claims 8 and 13, said method and system, wherein registering the wireless devices to receive advertising messages includes providing demographic information of a user of the wireless device (column 3, lines 19-29).

As per claims 27 and 34, said method and system, wherein the advertising message is location based (column 3, line 58 – column 4, line 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 7, 9, 12-14, 18-19, 23-24, 26-27, 30-31 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al.

As per claims 3-4, 19, 24 and 31, Angles et al. teach said method and system, wherein consumers are remunerated incentives as part of a bonus program for accepting the advertising messages (column 20, lines 33-36).

Angles et al. do not specifically teach that said incentives include points or additional air-time.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The "registering" through "remunerating" steps would be performed the same regardless of the type of incentives. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As per claims 7, 12 and 18, Angles et al. teach said method and system, wherein a user account for each registered wireless device is credited for accepting advertising messages (column 21, lines 19-24; column 16, lines 31-37).

Angles et al. do not specifically teach that said user's account is a user accessible account.

Official notice is taken that account accessibility is well known.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Angles et al. to include that said user account is a user accessible account, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Angles et al. would perform the invention as claimed by the applicant with either specifically teaching the accessibility of said user's account, or not.

As per claims 9 and 14, Angles et al. teach said method and system, wherein the advertising request received from the advertisers are stored in a database (column 8, lines 41-46).

Angles et al. do not specifically teach that said database is a second database.

Official notice is taken that it is well known that a database may be structured in any desirable manner.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Angles et al. to include that said database is a second database, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Angles et al. would perform the invention as claimed by the applicant with said database structured in any manner.

As per claims 23, 26, 30 and 33, Angles et al. teach said method and system, Including: sending the advertising messages to a registered wireless device (column 3, lines 41-46).

Angles et al. do not specifically teach that said advertising messages are text messages or coupons.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The "registering" through "remunerating" steps would be performed the same regardless of the content of the messages. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claims 6, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. in view of Bezos et al. (US 6,029,141).

As per claims 6, 15 and 20, Angles et al. teach all the limitations of claims 6, 15 and 20, except that users receive remuneration for referring an unregistered user to receive advertising messages.

Bezos et al. teach a method and system for an internet-based customer referral system, wherein registered users receive commissions for referring other users to merchant's site (column 1, line 62 – column 2, line 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Angles et al. to include that users receive remuneration for referring an unregistered user to receive advertising messages, because it would allow advertisers to expose their products to larger audience, thereby increase revenue.

Response to Arguments

Applicant's arguments filed 04/21/04 have been fully considered but they are not persuasive.

In response to applicant's argument that Angles et al. fails to disclose "registering a wireless device", the examiner stipulates that Angles et al. explicitly teaches that the consumer computer (12), which is an interactive wireless communications device (C.

10, L. 36-37), registers with the advertisement provider computer by first establishing a communications link with the advertisement provider computer (C. 16, L. 57-59), assigning the consumer member code (22) to the consumer and then storing the assigned consumer member code (22) in the consumer computer (12) (C. 17, L. 25-33).

In this particular case *assigning the consumer member code (22) to the consumer* has the effect of *assigning the consumer member code (22) to the consumer computer*, because communications between the consumer and the service provider are made over the consumer computer.

In response to applicant's argument that the examiner did not explain why the *specific content* of the incentives rewarded to the consumers for accepting the advertising messages is *non-functional descriptive material*, the examiner points out that said explanation was provided on page 4 of the last Office Action of 1/22/04. Specifically, the method steps of: *registering a wireless device to receive advertising messages; receiving registration information including at least a wireless device number and storing said information in a database; receiving advertising messages from advertisers; sending the advertising messages to a registered wireless device; remunerating users for accepting the advertising messages to their registered wireless devices* would be performed the same regardless of the type or the specific content of the rewards. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gunlock*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps disclosed in Angles et al. would be performed the same regardless of the type or the specific content of the rewards.

In response to applicant's request to provide evidence that it is well known to access by a user his/her own account, the examiner refers to US 6,484,946 to Matsumoto et al, disclosing that a user is able to accesses his account to review confidential information, including points accumulated and redeemed at participating merchants (C. 12, L. 11-18). Moreover, similar teachings are disclosed in US patents 6,511,377 to Weiss; 6,484,147 to Brazening et al; 6,015,344 to Kelly et al; 6,003,013 to Bushy et al.

In response to applicant's request to provide evidence that it is well known to structure a database in any desirable manner, the examiner maintains that creating separate databases is old and well established practice. See, for example, US 5,931,901 to Wolfe et al, teaching a first database containing consumer's profiles, and a second database containing a variety of advertising messages (C. 8, L. 15-20). Furthermore, similar database arrangements are disclosed in US patents 6,529,143 to Mikkola et al; 6,356,893 to Itakura et al; 6,404,884 to Marwell et al; 5,758,257 to Herz et al.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both Angles et al. and Bezos et al. relate to delivering customized electronic advertisement in e-commerce environment. The motivation to combine Angles et al. and Bezos et al. is that the business arrangement, disclosed in Angles et al., would benefit from allocating commissions to registered users for referring other users to merchant's site, as disclosed in Bezos et al, because it would allow advertisers to expose their products to larger audience, thereby increase revenue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


DENNIS RUHL
PRIMARY EXAMINER